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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/889,889	07/08/1997	PATRICK J. SULLIVAN	063074.0104	4013

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EXAMINER	
RAO, ANAND SHASHIKANT	

ART UNIT	PAPER NUMBER
2613	

DATE MAILED: 04/21/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/889,889	SULLIVAN ET AL.	
	Examiner	Art Unit	
	Andy S. Rao	2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with respect to claims 1-42 as filed in Paper 16 on 2/03/04 have been fully considered but they are not persuasive.

2. Claims 1-3, 9-13, 15-24, 26-32 and 34-42 remain rejected under 35 U.S.C. 102(e) as being anticipated by Schwab, (US Patent: 5,973,731 hereinafter referred to as "Schwab"), as was set forth in the Prior Office Action of Paper 15 mailed on 11/7/03.

3. Claims 4, 14, 25-26 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab in view of Ishida et al., (US Patent: 5,585,839 hereinafter referred to as "Ishida"), as was set forth in the Prior Office Action of Paper 15 mailed on 11/7/03.

4. The Applicant presents five arguments contending the Examiner's pending collective rejections of claims 1-3, 9-13, 15-24, 26-32 and 34-42 under 35 U.S.C. 102(e) as being anticipated by Schwab, (US Patent: 5,973,731 hereinafter referred to as "Schwab"), of claims 4, 14, 25-26 under 35 U.S.C. 103(a) as being unpatentable over Schwab in view of Ishida et al., (US Patent: 5,585,839 hereinafter referred to as "Ishida"), said rejections being previously set forth in the prior Office Action of Paper 15 mailed on 11/7/03. However, after a careful consideration of the arguments presented, and further analysis of the applied references, the Examiner must respectfully disagree for the reasons that follow.

After addressing the instant invention versus the Applicant's summary of the Schwab reference (Paper 16: page 9, lines 4-34), the Applicant argues that Schwab fails to read upon the "a client operable to perform a financial transaction..." as in claim 1 (Paper 16: page 10, lines 1-15). In particular, it is noted that the citation of question would show that the client would be

able to generate data from a financial transaction or the image files generated from the transaction database at the client (Schwab: column 7, lines 22-25). As to showing that the client itself performs said financial transaction, that is shown in Schwab as well. It is noted that Schwab discloses that the client is a transaction terminal (Schwab: column 7, lines 60-65), and further that this transaction terminal would be a financial terminal such as an ATM (Schwab: column 9, lines 23-43), as in the claims. Accordingly, the Examiner maintains that the limitation is met.

Secondly, the Applicant argues that Schwab fails to disclose having the "client having a camera..." as in the claim (Paper 16: page 10, lines 16-23). The Examiner respectfully disagrees. It is noted that those are generated video sources at the client, said video being generated by a camera at the client (Schwab: column 4, lines 24-30), and further that the transactions are this video is a financial transaction data (Schwab: column 7, lines 1-15), and to transmit the generated data to the central server at to update the central database (Schwab: column 4, lines 40-50). Accordingly, the Examiner maintains that this feature is met as well.

Thirdly, the Applicant argues that Schwab fails to teach "a server coupled to the client using a communication network..." as in the claims (Paper 16: page 10, lines 24-33; page 11, lines 1-2). The Examiner respectfully disagrees. It is noted that the citations question show the flow of data, and the kind of data being sent to the server is further qualified in the client's generation of a local database wherein said database is concerned with a data and associated video generated in relation to a financial transaction. It is noted that the pre-existing image as sent to the client would relate the a user's prior transaction data for subsequent verification at the client site in order resolve disputes between the client user, and a customer or the originator of

the financial transaction (Schwab: column 7, lines 5-15). Additionally, just in general, generation of a location database of financial transactions at the client could easily be sent to the central server to update the central database as in the claims (Schwab: column 4, lines 45-50). Accordingly, the Examiner maintains that this limitation is met as well.

Additionally, the Applicants argue that claim 22 was analyzed in of its own merits (Paper 16: page 11, lines 3-24). It is noted that each element was summarily addressed, and short of the Applicant specifically countering that stance, this argument is not responsive. However, it is noted that as to the surveillance system recited in the preamble, In response to applicant's arguments, the recitation "surveillance system" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). However, that being said, it is noted that Schwab would read upon a more positively recited surveillance system as it discloses having the central server located at some sort of legal authority for surveillance (Schwab: column 9, lines 25-30). Accordingly, Schwab meets this limitation as well.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (Paper 16: page 11, lines 23-31; page 12, lines 1-9), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The Examiner notes that Schwab discloses using a video-phone transaction terminal to transmit both image/audio information to a central server (Schwab: column 2, lines 15-25). It is submitted that the disclosure of the a video-phone as the client or transaction terminal makes the incorporation of audio data obvious, and further shows that the Examiner didn't rely upon knowledge gleaned only from the applicant's disclosure, and thus the Examiner's reconstruction is proper. Furthermore, the Applicant argues that the two references teach away from such a combination, as Schwab fails to show a person or persons associated with the central image file server (Paper 16: page 12, lines 10-20). The Examiner respectfully disagrees. It is noted that while the preferred embodiment of the Schwab central server is as a stand-alone element, the reference is not necessarily confined to the depiction of its preferred embodiment, *In re Boe,* 148 USPQ 507 (CCPA 1966*)*. The reference does allow for the presence of human operators at the central server site, especially in connection with some legal authority (Schwab: column 9, lines 20-43). Accordingly, having a financial transaction terminal sending information to one of these central server facilities would require human input to not only send back a positive database match, but further client instructions concerning the originator of the financial transaction. The Examiner is at a loss to comprehend how Applicants could arrive at the specious conclusion that the incorporation of audio data into the Schwab central server would not make sense technically, and would require further clarification on this position before answering (Paper 16: page 10, lines 13-15). And in response to the Applicant's piecemeal analysis of In response to applicant's

arguments against the references individually (Paper 16: page 12, lines 14-20) one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Since the Examiner maintains that the Schwab reference shows all of the features as discussed above, Ishida does not need to address these features only show sufficient disclosure concerning the audio data and audio file generation.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andy S. Rao whose telephone number is (703)-305-4813. The examiner can normally be reached on Monday-Friday 8 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris S. Kelley can be reached on (703)-305-4856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andy S. Rao
Primary Examiner
Art Unit 2613

ANDY RAO
PRIMARY EXAMINER

asr
April 19, 2004